

## **REMARKS**

This is in response to the Office Action dated July 15, 2010. In view of the above amendments and the following remarks, reconsideration of the rejection and further examination are requested.

By this amendment, claim 25 has been cancelled and its subject matter has been incorporated into claims 23, 40, and 41.

The Examiner has asserted that the reference EP 1001640, submitted with the IDS dated March 22, 2006, has not been considered because the IDS did not include a concise explanation of the relevance of EP 1001640.

As indicated in MPEP §609.04(a)(III), a concise explanation of the relevance of the reference is required for foreign references not listed in the English language. However, “[w]here the [reference] is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y", or "A" indication on a search report” (emphasis added) (see MPEP § 609.04(a)(III)).

In this regard, Applicants note that page 2 of the International Search Report issued in International Application No. PCT/JP2004/014993, filed concurrently with the IDS, explicitly indicates the relevance of EP 1001640 using a designation of “X” on the search report. Therefore, Applicants respectfully request that EP 1001640 be considered.

### **Rejections under 35 U.S.C. §101:**

Claims 1-3, 7, 10-14, 18, 21-25, 29, and 32-41 have been rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. This rejection is submitted to be inapplicable to the claims, as amended, for the following reasons.

Independent claims 1, 35, and 37 have been amended to recite “a processor” and “a judging unit operable to judge, using the processor...” Independent claims 38 and 40 have been amended to recite “using a processor” to receive the requisition request. Independent claims 39

and 41 have been amended to recite a “non-transitory computer readable recording medium on which a data protection program...is recorded. Thus, independent claims 1, 35, and 37-41 are directed to statutory subject matter under 35 U.S.C. § 101.

Claims 2, 3, 7, 10-14, 18, 21-24, 29, 32-34 are either directly or indirectly dependent on independent claim 1. Claim 36 is dependent on independent claim 35. Therefore, claims 1-3, 7, 10-14, 18, 21-24, 29, and 32-41 are now clearly directed to statutory subject matter under 35 U.S.C. § 101. As a result, Applicants respectfully request that the Examiner withdraw the rejection of claims 1-3, 7, 10-14, 18, 21-24, 29, and 32-41 under 35 U.S.C. § 101.

**Rejections under 35 U.S.C. §103(a):**

Claims 1-3, 7, 10, 21, 22, 35, 38, and 39 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamada (US Pub. 2003/0135748) in view of Mclean (US 5,282,247). This rejection is submitted to be inapplicable to the claims, as amended, for the following reasons.

Claim 1 recites a record carrier comprising:

a storage unit;

a processor;

a requisition receiving unit operable to receive, from a terminal device having the record carrier attached thereto, a requisition for access to the storage unit;

an acquisition unit operable to acquire an access condition indicating whether or not the terminal device is authorized to access the storage unit;

a judging unit operable to judge, using the processor, whether or not the requisition satisfies the access condition; and

a prevention unit operable to prevent the access of the terminal device to the storage unit when the judging unit judges that the requisition does not satisfy the access condition.

As is evident from the language in claim 1 shown above, the storage unit, the processor, the requisition receiving unit, the acquisition unit, the judging unit, and the prevention unit are included in the record carrier. By including such elements in the record carrier itself, the record carrier is able to prevent unauthorized access to the data stored therein by requiring a separate terminal device to satisfy an access condition before data on the record carrier can be accessed.

The combination of Yamada and McLean fails to disclose or suggest the above features as recited in claim 1.

Yamada discloses a system for restricting access and storage of content that is downloaded from a content provider and stored in a memory 410 of a communication device such as a portable phone 40 (see paragraph [0007]). According to Yamada, a user operates a portable phone 40, into which the user's UIM 50 (User Identity Module) is inserted, to display a list of data or programs stored in memory 410 (see paragraph [0092]). The user then selects either data or a program from a list of displayed content (see paragraph [0092]).

To access the selected content stored in the memory 410, the CPU 405 transmits to the UIM 50 inserted into the phone 40, an ID transmission request S301 (see paragraph [0100]). After the CPU 405 of the phone 40 acquires the UIMID from the UIM 50 (see paragraph [0100]), the CPU 405 of the phone 40 compares the received UIMID from the UIM 50 to the UIMID registered in the owner registration area 410b of the phone 40 (see Figure 2) to determine if the UIM 50 inserted into the phone 40 matches the owner of the phone 40 (see paragraph [0101]). If the UIMID transmitted by the UIM 50 does not match the UIMID stored in the owner information registration area 410b, the CPU 405 of the phone 40 displays a message stating that access to the phone's memory 410 is not permitted and cancels the execution of a reading operation (see paragraph [0102]).

In the Office Action, the Examiner asserts that Yamada discloses a storage unit 407 (which contains the memory 410 discussed above), a requisition unit (the CPU 405 of the phone 40 making the ID transmission request S301), an acquisition unit (CPU 405 of the phone 40 acquiring the UIMID S302 from the UIM 50), a judging unit (the CPU 405 of the phone 40 comparing UIMIDs S303), and a prevention unit (the CPU 405 of the phone cancelling execution of reading operation) (see Office Action, page 4, item 10). It is noted that each of the above "units" in Yamada are part of the phone 40, and not the UIM 50. Thus, it is not clear how the "requisition unit" disclosed in Yamada would "receive from the terminal device...a requisition for access to the storage unit," as recited in claim 1, since the phone 40 of Yamada is equivalent to the "terminal device" of claim 1.

The Examiner further asserts that it would have been obvious to modify the system of Yamada (presumably the phone 40 and UIM 50 together) to include the method for protecting data stored on the removable storage device against unauthorized access, as disclosed in McLean

(see Office Action, pages 4-5, item 11). However, it is again noted that the above “units” are part of the phone 40 and not the UIM 50.

In this regard, Yamada indicates that the UIM 50 would ideally be used to store, in addition to user ID and the like, a substantial amount of downloaded content (see paragraph [0005]). As explicitly noted in Yamada, however, “the physical limitations of a UIM card prevent such storage, and it is feasible to store only a small amount of such information in a memory of the UIM” (emphasis added) (see paragraph [0005]). Thus, in view of the physical limitations of the UIM card disclosed in Yamada, Applicants submit that it would not have been obvious to modify Yamada so as to incorporate the above discussed structure of the phone 40 into the UIM 50. Accordingly, no obvious combination of Yamada and McLean would result in, or otherwise render obvious under 35 U.S.C. §103(a), the above discussed features of the record carrier as recited in claim 1. Therefore, claim 1 is patentable over the combination of Yamada and McLean.

Claim 35 is patentable over the combination of Yamada and McLean for at least the same reasons as those discussed above with regard to claim 1.

Claims 38 and 39 recite (a) receiving from a terminal device having the record carrier attached thereto, a requisition for access to the storage unit, (b) acquiring, from the access condition storage unit, an access condition indicating whether or not the terminal device is authorized to access the storage unit, (c) judging whether or not the requisition satisfies the access condition, and (d) preventing the access to the storage unit when the step (c) judges that the requisition does not satisfy the access condition. For at least reasons similar to those discussed above with regard claim 1, claims 38 and 39 are also patentable over the combination of Yamada and McLean.

Claims 2, 3, 7, 10, 21, and 22 are either directly or indirectly dependent on independent claim 1. As a result claims 1-3, 7, 10, 21, 22, 35, 38, and 39 are allowable over the combination of Yamada and McLean.

Claims 11-14 and 18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamada (US Pub. 2003/0135748) in view of McLean (US 5,282,247) and further in view of Menezes (Handbook of Applied Cryptography, CRC Press, 1996). This rejection is submitted to be inapplicable to the claims, as amended, for the following reasons.

Claims 11-14 and 18 are ultimately dependent on independent claim 1 discussed above in detail.

It is apparent that Menezes fails to disclose or suggest the features lacking from the combination of Yamada and Mclean discussed above with regard to independent claim 1. Accordingly, no obvious combination of Yamada, Mclean, and Menezes would result in, or otherwise render obvious under 35 U.S.C. §103(a), the features recited in claims 1, 11-14, and 18. Therefore, claims 1, 11-14, and 18 are patentable over the combination of Yamada, Mclean, and Menezes.

Claims 23-25, 29, 32-34, 36, 37, 40, and 41 have been under 35 U.S.C. § 103(a) as being unpatentable over Yamada (US Pub. 2003/0135748) in view of Mclean (US 5,282,247) and further in view of Fransdonk (US Pub. 2003/0167392). This rejection is submitted to be inapplicable to the claims, as amended, for the following reasons.

Claims 23-24, 29, and 32-34 are ultimately dependent on independent claim 1 discussed above in detail. Claim 36 is dependent on independent claim 35 discussed above in detail.

Claim 37 is patentable for at least the same reasons as those discussed above with regard to independent claim 1.

Fransdonk is relied upon in the rejection as disclosing a condition access agent that securely retrieves and caches product key information and access criteria (see paragraph [0059]). However, it is apparent that Fransdonk fails to disclose or suggest the features lacking from the combination of Yamada and Mclean discussed above with regard to independent claims 1, 35, and 37.

Furthermore, claim 23 recites a record carrier including a judging unit, wherein the judging unit judges that, (i) when an identifier matching the requiring device identifier is included in the identifier list, the requisition satisfies the access condition, and (ii) when an identifier matching the requiring device identifier is not included in the identifier list, the requisition does not satisfy the access condition.

The Examiner explicitly relies on Yamada as disclosing the above discussed feature of claim 23 (see Office Action, page 15, item kk, referring to claim 25). As discussed above with regard to claim 1, Yamada discloses that the CPU 405 of the phone 40 compares the received UIMID from the UIM 50 to the UIMID registered in the owner registration area 410b of the

phone 40 to determine if the UIM 50 inserted into the phone 40 matches the owner of the phone 40 (see paragraph [0101]), and if it does not match, the CPU 405 of the phone 40 displays a message stating that access to the phone's memory 410 is not permitted and cancels the execution of a reading operation (see paragraph [0102]). However, as noted above, the judging unit is part of the phone 40 and not the UIM 50. Therefore, the combination of Yamada, Mclean, and Fransdonk does not disclose or suggest the record carrier as recited in claim 23. As a result, claim 23 is patentable over the combination of Yamada, Mclean, and Fransdonk.

The above discussed feature as recited in claim 23 allows an access requisition from the terminal device owned by the other person to be refused, when necessary, to protect personal data stored in the record carrier. This feature is useful when, for example, a user loses the terminal device (e.g., a mobile telephone) with the record carrier attached, and another person attempts to use the user's record carrier with a different terminal. Thus, if the above features as recited in claim 23 were part of the phone and not the record carrier, the record carrier would be unable to protect the personal data stored in the record carrier.

Claim 23 also recites a communication unit operable to communicate with an access condition management server connected via a network, wherein the acquisition unit (i) transmits one of the identification information pieces that identifies the record carrier to the access condition management server via the communication unit, and (ii) acquires the access condition corresponding to the one of the identification information pieces from the access condition management server via the communication unit.

The Examiner explicitly relies on Fransdonk as disclosing the above discussed feature of claim 23 (see Office Action, pages 13-14, item 30). Fransdonk discloses a condition access agent that securely retrieves and caches product key information and access criteria (see paragraph [0059]). For example, the conditional access agent 28 may evaluate a content request from a content destination 22 based on access criteria specified by a content provider 16, local date and time information, and user credentials and authentication (see paragraph [0059]).

However, the combination of Yamada, Mclean, and Fransdonk does not disclose or suggest an acquisition unit of a record carrier that (i) transmits one of the identification information pieces that identifies the record carrier to the access condition management server, and (ii) acquires the access condition corresponding to the one of the identification information

pieces from the access condition management server via the communication unit. As a result, claim 23 is patentable over the combination of Yamada, Mclean, and Fransdonk.

The above discussed feature as recited in claim 23 allows an access condition, used to judge whether or not the access to the record carrier is authorized, to be stored in an external access condition management server, instead of the record carrier itself. This feature is useful because a system administrator is able arbitrarily change the access condition stored in the access condition management server. For example, when a user loses the terminal device having the record carrier attached, the administrator can quickly alter the access condition stored in the access condition management server to make the user's terminal device inaccessible. This prevents another person from operating the user's terminal device and retrieving personal data stored in the record carrier.

Claims 40 and 41 recite transmitting an identification information piece that identifies the record carrier to an access condition management server via the communication unit, and acquiring from the access condition management server an access condition corresponding to the identification information piece via the communication unit, the access condition indicating whether or not the terminal device is authorized to access the storage unit, and judging whether or not the requisition satisfies the access condition, wherein (i) when an identifier matching the requiring device identifier is included in the identifier list, the requisition satisfies the access condition, and (ii) when an identifier matching the requiring device identifier is not included in the identifier list, the requisition does not satisfy the access condition. Therefore, claims 40 and 41 are patentable over the combination of Yamada, Mclean, and Fransdonk for at least reasons similar to those discussed above with regard to claims 38 and 23.

Accordingly, no obvious combination of Yamada, Mclean, and Fransdonk would result in, or otherwise render obvious under 35 U.S.C. §103(a), the features recited in claims 1, 23-25, 29, 32-37, 40, and 41. Therefore, claims 1, 23-25, 29, 32-37, 40, and 41 are patentable over the combination of Yamada, Mclean, and Fransdonk.

Withdrawn claims 4-9, 15-17, 19, 20, 26-28, 30, and 31 include all the features of allowable claim 1. As a result, Applicants respectfully request that the Examiner rejoin withdrawn claims 4-9, 15-17, 19, 20, 26-28, 30, and 31 to the application.

Because of the above-mentioned distinctions, it is believed clear that claims 1-24 and 26-41 are allowable over the reference relied upon in the rejection. Furthermore, it is submitted that the distinctions are such that the present invention, as recited in claims 1-24 and 26-41, would not have been obvious to a person having ordinary skill in the art at the time of the invention. Therefore, it is submitted that claims 1-24 and 26-41 are clearly allowable over the prior art of record.

In view of the above amendments and remarks, it is submitted that the present application is now in condition for allowance. The examiner is invited to contact the undersigned by telephone if it is felt that there are more issues remaining which must be resolved before allowance of the application.

Respectfully submitted,

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